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09/917,469	07/27/2001	Fabio Cineffi	CM-2017MC	1554

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EXAMINER

WYROZEBSKI LEE, KATARZYNA I

ART UNIT PAPER NUMBER

1714

DATE MAILED: 02/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/917,469

Applicant(s)

CINELLI ET AL.

Examiner

Katarzyna Wyrozebski Lee

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

In view of the updated search report, which yielded PG PUG of the present invention applicable for Obviousness Double Patenting rejection, following office action is second non-final. All the rejections over the prior art of record are not withdrawn. Newly added claim is a product by process claim, to which the examiner was not able to determine satisfactory support in the specification. Proper rejection will be applied

### ***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9, 12-13, 19-21 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14, 19 of co-pending Application No. 09/917505 ('505). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following explanation.

Co-pending application '505 discloses adhesive for disposable article, where the adhesive has initial and final peel strength in a ratio of 2:1 to 4:1 and wherein water absorption capacity is at least 3% by weight (Claim 1).

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In claim 2, co-pending application discloses that the ratio of initial to final peel strength is from 2:1.23 to 2:4. The initial peel strength ranges from 0.1 N/cm to 5.0 N/cm (claim 3) preferably 0.5 N/cm to 3.0 N/cm (claim 4).

The adhesive has thickness C, viscous modulus and elastic modulus measured at frequencies of 100 rad/sec and 1 rad/sec and temperature of 25°C, wherein the values claimed are the same in both applications.

The polymers utilized in an adhesive are acrylics sulfonated polymers, vinyl alcohols, vinyl pyrrolidone, polyethylene oxide and mixtures thereof (claim 10). While the plasticizers are polyhydric alcohols, polyethylene glycols, glycerols, sorbitols, water and mixtures thereof.

The adhesive is mixed hydrophobic/hydrophilic phase adhesive wherein the ratio of hydrophilic to hydrophobic component is 5:1 to 1:5 and the Preferred range for the plasticizer is 50:1 to 1:50. The weight of the adhesive is utilized in is 20-2500 m<sup>2</sup>/g.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art to arrive at the adhesive of the present invention while practicing the adhesive claimed in co-pending '505 application. Especially when the claims shadow each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1 and 21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

On page 16 of the present invention, last paragraph the applicant's discloses that the amount of the hydrophilic monomer is 5-50 % by weight of the reaction mixture , the amount of plasticizer is 10-50 % by weight of the reaction mixture and 10-50 % by weight of the reaction mixture of hydrophobic monomer. In the newly added claim 21 the applicant requires that the hydrophilic monomer be utilized in the amount of about 5-50%, plasticizer in amount of about 10-50 %, from about up to 50% of nonionic monomer (which per specification is also defined as hydrophobic monomer) and up to about 40 % of water. The applicant therefore does not have support for the numerical ranges claimed in claim 21. Term about encompasses amounts lower than those disclosed in the present invention. I addition the amount of the hydrophobic monomer and water as recited in claim 21 can actually be lower than that taught by the specification.

In similar matter, the applicant has no support for "at least about 3 % water" in claim 1.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claim 1 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, line 9 recites term "at least about". The term renders claim indefinite, since it is not clear if the amount of water is at least 3% or about 3 %.

With respect to claim 21, recitation of "up to about" renders claim indefinite, since it is not clear if the amount of water and hydrophobic monomer is "up to" given amount or "about" given amount. In addition the limitation of hydrophobic monomer contains recitation of "from about up to" which renders claim even more confusing.

### *Specification*

The foreign documents, to which this invention claims priority has to be included at the beginning of the specification.

### *Claim Objections*

7. Claim 5 is objected to because of the following informalities: The units of the thickness of the adhesive are not given. Appropriate correction is required.
8. Claim 12 is objected to because of the following informalities: Claim 12 recites polymers, where the group from which the polymers can be selected lists monomers. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-11, 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Dietz (WO 97/05171).

The discussion of the disclosure of the prior art of Dietz from paragraph 5 of the office action mailed on 9/25/2002 is incorporated here by reference.

***Claim Rejections - 35 USC § 103***

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 12, 13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz (WO 97/05171) in view of Bischoff (WO 97/24149).

The discussion of the disclosure of the prior art of Dietz and Bischoff from paragraph 9 of the office action mailed on 9/25/2002 is incorporated here by reference. Newly added claim

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21 recites use of monomer to form an adhesive, wherein monomers are taught by the prior art of Bischoff.

13. Claims 5-15, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz (WO 97/05171) in view of Corzani (EP 855,190).

The discussion of the disclosure of the prior art of Dietz and Corzani from paragraph 10 of the office action mailed on 9/25/2002 is incorporated here by reference.

14. Claims 16, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dietz (WO 97/05171) in view of Boundry (US 6,227,106).

The discussion of the disclosure of the prior art of Dietz and Boundry from paragraph 11 of the office action mailed on 9/25/2002 is incorporated here by reference.

#### *Priority*

The applicant still did not submit priority documents. In order to have benefit of the priority filling date these documents have to be submitted.



*Response to the Amendment*

In the response faxed on December 10, 2002 the applicant argued the following:

a) The adhesive of the present invention, as required by the present claims is hydrated, whereas the adhesive of the prior art of Dietz is dehydrated:

With respect to the above argument, the limitation of the claim as it was submitted in September reads:

“...wherein said adhesive comprises at least about 3% water after one hour of equilibration at about 50% relative humidity.”

When considering the above limitation, it is examiner's position, that the language provides more of a test result than the property required by the claim. It is therefore examiner's position, that when two similar if not the same adhesives are subjected to the same test, the results will also be similar if not the same.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski Lee whose telephone number is (703) 306-5875. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Katarzyna Wyrozebski*

KIWL

February 20, 2003